



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/821,445

03/29/2001

Asit Dan

YOR920010137US1

1775

7590

08/11/2006

Gail H. Zarick
IBM CORPORATION
Intellectual Property Law Dept.
P.O. Box 218
Yorktown Heights, NY 10598

EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/821,445	Applicant(s) DAN ET AL.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/18/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-34 are pending. The rejections are as stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, in line 1, it is unclear what is being referred to by the term "each". Examiner suggests changing to "each party".

4. Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, "Open Buying on the Internet" is an industry standard, which may change over time, and it would be inappropriate to have the scope of the claim change over time. Therefore, the recitation of "Open Buying on the Internet" renders the claim indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-6, 8, 9, 12-17, 22-34 rejected under 35 U.S.C. 102(a) as being anticipated by “A Replicable Web-Based Negotiation Server for E-commerce,” by Su, Huang, and Hammer, from the proceedings of the 33rd Hawaii International Conference on System Sciences.

The paper by Su, Huang and Hammer (herein referred to as Su) teaches a network of negotiation servers which perform electronic negotiations based on user instructions. The system and method described by Su teaches:

Claim 1, 2, 5, 8, 9, 12-17, 24-34 parties having their own trusted negotiation servers to conduct negotiations, connected to a communications network, able to communicate with other negotiation servers, a client of a negotiation server registers a set of negotiation rules, making up a negotiation protocol, which specify the negotiation strategies/tactics to be followed when constraints are violated during negotiations (page 2 column 2), a client issuing a request to negotiate for a product or service (page 3 column 1), and the negotiation being conducted automatically between the negotiation servers, under the rules of the

Art Unit: 3624

negotiation protocol as defined by the clients, the proposal being stored as an object in a persistent repository (page 4 column 1), and the system using a graphical user interface.

Claim 3, 4, the process of proposal, counterproposal will continue until an agreement is reached, and a contract formed, or either side terminates the negotiation process (page 3 column 2).

Claim 6, 22, 23 the negotiation protocol lists rules in 3 parts: condition under which action should be taken, the action to take if the condition is met, and the action to take if the condition is not met. Su cites, as an example, a request for human intervention (page 5 column 1), where human negotiation experts can dynamically add or change negotiation rules.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3624

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Su.

Su fails to teach specific rules and constraints for which to trigger the human intervention action. Su teaches the client specifies the negotiation protocol to be used by the client's negotiation server. Su also teaches human intervention as an action resulting from the occurrence or certain defined events. Therefore, it would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Su to include the specific events of suspending and resuming negotiations under certain time conditions as defined by the client, as the modification would define the point at which human intervention is required, and would allow automatic negotiation to automatically resume after said human intervention.

10. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. U.S. Patent No. 5,794,207

Claim 24, Walker fails to teach the application having a graphical user interface. Official notice is taken that including a graphical user interface in an application facilitating the trading and purchasing of goods and services is old and well known in the art. It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention for to use a graphical user interface as the user interface of Walker, because

doing so would result in a user friendly environment, which would increase the desire to use the disclosed system.

11. Claims 1-5, 7-9, 11-17, 22, 23, 25-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. U.S. Patent No. 5,794,207, in view of "Supporting the Negotiation Life Cycle," by Robinson and Volkov.

Walker discloses a method and apparatus for a commercial network system designed to facilitate buyer-driven conditional offers. The system and method disclosed by walker teaches:

Claim 5, 12, 23, 29, A buyer having a connection to a communications network via a first computer system and interface, and a seller having a connection to a communications network via a computer system and interface, the system acting as an intermediary or broker between a buyer and a seller (figures 1, 3, 4);

Claims 4, 8, 25-27, 32, Proceeding through the negotiation according to the steps which take place in the system, completing each step before moving ahead with negotiations, assuring the system practices proper steps of an offer, an acceptance, and a consideration, required to form a legally binding contract (column 4 lines 33-34);

Claims 8, 6, 12, 17, A user providing a starting state for a contract negotiation by completing a template in the system to formulate a conditional purchase offer (CPO) including entering a description of the goods or services involved, and the conditions that must be met in order to satisfy the contract, an expiration date for the settling of negotiations (figure 5 and column 15 line 60 – column 16 line 62);

Claim 12, 14, The user inputted information being placed into a prewritten contract template with language acquired from a contract detail database, including the legal language necessary to make the CPO a complete legally binding contract (column 17 lines 1-7);

Claims 9, 11-13, The CPO being uploaded into a database and activated and being published in a publicly searchable form (column 17 lines 48-53);

Claims 3, 22, A sub-negotiation in which the seller is presented with the current CPO and proceeds to modify certain conditions he wishes to change (column 22 lines 56-60);

Claim 7, Informing parties of the negotiation state via central controller contacting the buyer when a negotiation has been made, and the controller contacting a qualified seller when a pertinent CPO is posted by a buyer. (column 15 lines 56-57, column 18 lines 30-36);

Claims 1, 2, 15, 28, 30, 31, 33, 34, Walker fails to teach users specifying the negotiation protocol in a negotiation meta contract, and using said meta contract to carry out negotiations.

"Supporting the Negotiation Life Cycle" teaches basic principles and well known practices of negotiation, known as the negotiation life cycle. The reference teaches "participants must agree on a negotiation protocol. A negotiation protocol defines how agents communicate through an ordered interchange of structured messages... software agent negotiation protocols are even more disciplined in their definition of

Art Unit: 3624

interaction and message structures" (page 5, 2nd paragraph). The system and method disclosed by Walker inherently defines a protocol for negotiations of the CPOs, which are agreed upon by users through the act of using the system. Users may also define, within the CPO, stipulations for the execution of the contract, such as arbitration protocols in the event of a dispute (column 30 lines 47-52). Therefore, it would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to specify certain steps of the negotiation protocol prior to entering negotiations. Further, in view of "Supporting the Negotiation Life Cycle", which teaches that a negotiation protocol is necessarily defined in any negotiation, it would be obvious to include a step in the method, in which the users define certain protocols before submitting the CPO, rather than within the CPO, as Walker teaches.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read "Vincent Millin", written in a cursive style.